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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/454,349	12/03/1999	MICHAEL A. EPSTEIN	PHA-23-637	3613

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EXAMINER	
SHERR, CRISTINA O	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/454,349	EPSTEIN, MICHAEL A.	
	Examiner	Art Unit	
	Cristina O Sherr	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is in response to Applicant's amendment filed 4 November 2002. Claims 1, 3-6, 8, 9, 11 and 12 have been amended. Claims 1 – 20 remain pending in this case.

Response to Arguments

2. Applicant's arguments filed 4 November 2002 have been fully considered but they are not persuasive. Applicant argues that neither Kocher nor Boebert shows a recording indicator, a secure item based on unique identifier, a rendering device basing its decrypting of the encrypting information content material on a current value of the recording indicator. Examiner directs Applicant's attention to Kocher Col. 5, ln 55 – Col. 6 ln 3 and Boebert Col. 6, ln 6-16. Applicant further argues that neither Kocher nor Boboert disclose a rendering device having an authorization device predicating the rendering of content material based on a usage-measure. Examiner directs Applicant's attention to Kocher Col. 5, ln 55 – Col. 6 ln 3.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher et al (US 6,289,455 B1) in view of Boebert et al (US 5,864,683A).

5. Kocher teaches a recording medium comprising a first memory that is configured to store encrypted content material via a first write operation, a recording indicator that is configured to contain a unique identifier at each occurrence of the first write operation, and a second memory that is configured to store, via a second write operation, a secure item based on the unique identifier when the encrypted content material is stored (Col. 5, ln 55 – Col. 6 ln 3). Kocher further discloses the recording medium of claim 1, above, wherein the secure item includes an encrypted key that facilitates a decryption of the encrypted content material, the encrypted key being dependent upon the unique identifier (Col. 5, ln 55 – Col. 6 ln 3). Kocher does not, however disclose the recording medium of claim 1, above, wherein the recording indicator includes a counter that is configured to be incremented by a recording device when the recording device records the encrypted content material (Boebert Col. 6, ln 6-16). Boebert, however, does, as noted above. It would be obvious to one of ordinary skill in the art to combine the teachings of Kocher and Boebert for greater efficacy in data protection.

6. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher et al (US 6,289,455 B1) in view of Boebert et al (US 5,864,683A).

7. Kocher teaches a rendering device that is configured to render content material corresponding to encrypted content material that is contained on a recording medium, the recording medium also including a recording indicator that contains an original value, the rendering device comprising one or more decrypters that are configured to decrypt the encrypted content material 5 based on a current value of the recording

indicator, such that the one or more decrypters provide the content material only when the current value of the recording indicator corresponds to the original value of the recording indicator, and a renderer that is configured to render the content material (Col. 11, ln 33-65); further including an authorization device that is configured to control the renderer based on a usage-measure associated with the recording medium and a validity period associated with the content material (Col. 11, ln 33-65); further including a key generator that creates a unique key based on the current value of the recording indicator, and wherein the one or more decrypters are configured to decrypt the encrypted content material based on the unique key that is based on the current value of the recording indicator (Col. 11, ln 33-65). Kocher does not, however, disclose a rendering device wherein the one or more decrypters include a first decrypter that decrypts a doubly encrypted content key based on a private key of the rendering device to provide a singly encrypted content key, a second decrypter that decrypts the singly encrypted content key based on the unique key that is based on the current value of the recording indicator to provide a content key, and a third decrypter that decrypts the encrypted content material based on the content key to provide the content material (Boebert, Co. 29, ln 10-35). Boebert, however, does, as noted above. It would be obvious to one of ordinary skill in the art to combine the teachings of Kocher and Boebert for greater efficacy in data protection.

8. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher et al (US 6,289,455 B1) in view of Boebert et al (US 5,864,683A).

9. Kocher discloses a provider of content material comprising a recorder that is configured to record encrypted content material and a corresponding secure item on a recording medium, the encrypted content material being encrypted based on a content key, and the secure item being based on a value of a recording indicator of the recording medium when the encrypted content material is recorded on the recording medium (Col. 11, In 33-65); further comprising an allocator that is configured to allocate rendering rights associated with the encrypted content material, and wherein the recorder is further configured to record the rendering rights on the recording medium (Col. 9 In 22-60); wherein the secure item corresponds to an encryption of the content key based on the value of the recording indicator, further comprising one or more encrypters that are configured to provide the secure item (Col. 9 In 22-60);further including a key generator that generates a unique key based on the value of the recording indicator, and one or more encrypters that are configured to encrypt the content key based on the unique key to produce the secure item (Col. 9 In 22-60). Kocher does not, however, disclose the provider of claim 8, above, further comprising a first encrypter that encrypts the content key based on a unique key that is dependent upon a value of the recording indicator to produce a singly encrypted content key, and a second encrypter that encrypts the singly encrypted content key based on a public key that is associated with a rendering device to produce a doubly encrypted content key corresponding to the secure item (Boebert, Col. 29, In 10-35). Boebert, however, does, as noted above. It would be obvious to one of ordinary skill in the art to combine the teachings of Kocher and Boebert for greater efficacy in data protection.

10. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher et al (US 6,289,455 B1) in view of Boebert et al (US 5,864,683A).

11. Kocher discloses a method of providing content material, the method comprising recording encrypted content material on a recording medium, the encrypted content material being dependent upon the content material and a content key, and recording a secure item on the recording medium, the secure item being dependent upon a recording indicator that is associated with the recording medium (Col. 11, ln 33-65); further including recording rendering rights associated with the encrypted content material on the recording medium (Col. 9 ln 22-60); and generating a unique key that is based on the recording indicator, encrypting the content key using the unique key to produce the secure item (Col. 9 ln 22-60). Kocher does not, however teach the method of claim 14, above, wherein the method further including generating a unique key that is based on the recording indicator, encrypting the content key using the unique key to produce a singly encrypted content key, and encrypting the singly encrypted content key using a public key associated with a rendering device to produce the secure item. (Boebert, Col. 29, ln 10-35). Boebert, however, does, as noted above. It would be obvious to one of ordinary skill in the art to combine the teachings of Kocher and Boebert for greater efficacy in data protection.

12. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher et al (US 6,289,455 B1) in view of Boebert et al (US 5,864,683A).

13. Kocher discloses a method of rendering content material from a recording medium that includes encrypted content material, an encrypted content key, and a

recording indicator, the method comprising determining a unique key based on the recording indicator, decrypting the encrypted content key based on the unique key to provide a content key, decrypting the encrypted content material based on the content key to provide the content material, and rendering the content material; wherein the recording medium also includes rendering rights, and rendering the content material is dependent upon the rendering rights (Col. 11, ln 33-65). Kocher does not, however, disclose the method of claim 18, above, wherein decrypting the encrypted content key includes decrypting the encrypted content key based on a private key to provide a singly encrypted content key, and decrypting the singly encrypted content key based on the unique key to provide the content key (Boebert, Col. 29, ln 10-35). Boebert, however, does, as noted above. It would be obvious to one of ordinary skill in the art to combine the teachings of Kocher and Boebert for greater efficacy in data protection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Schneck et al (US 5,933,498A) teaches a system for controlling access and distribution of digital property.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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January 13, 2003

JAMES P. TRAMMELL
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